

U.S. Patent Application No. 10/565,460
Attorney Docket No. 13741/12
Reply to Office Action of December 30, 2008

REMARKS

Claims 16 and 17 are canceled herein without prejudice, and therefore claims 13 to 15 and 18 to 24 are pending in the present application.

It is respectfully submitted that the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the filed Information Disclosure Statement and for acknowledging the foreign priority claim and receipt of all certified copies of the priority documents.

Claim 14 was rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

While the rejection of claim 14 may not be agreed with, to facilitate matters, claim 14 has been rewritten without prejudice. Furthermore, claim features must be read in light of the specification. Claim 14, as presented, provides that the application process is not drive-relevant, as disclosed in the Specification at page 3, lines 18 to 29. Accordingly, claim 14, as presented, is allowable. Therefore, withdrawal of this rejection is respectfully requested.

Claims 13 and 16 to 19 were rejected under 35 U.S.C. § 102(b) as anticipated by German Patent No. DE 41 26 454 ("Gruendl et al.").

As regards the anticipation rejections of the claim, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Also, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the

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allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claims 16 and 17 have been canceled without prejudice.

As to claim 13, as presented, it includes the feature in which the “at least one consumer is connected to the AC/DC converter via a DC/DC converter”. Support for this feature may be found, for example, at page 5, lines 26 to 33 of the Specification, and in claims 16 and 17. As to Gruendl, even if it may indicate that a passive or active rectifier (GE) (a rectifier is an electrical device that converts alternating current (AC) to direct current (DC) (an AC/DC converter)) decouples the high frequency voltage, which energy is then available for auxiliary devices arranged in the vehicle (see Gruendl English language abstract (copy)), it does not anticipate claim 13, as presented. This is because it does not identically disclose (or even suggest) all of the features of claim 13, including, for example, the feature in which *at least one consumer is connected to the AC/DC converter via a DC/DC converter*, as provided for in the context of the claimed subject matter. This feature provides the advantage that each connected consumer may be operated at a different supply voltage despite using a single energy transmitting interface. (See Specification, page 5, lines 26 to 33).

Accordingly, claim 13 is allowable, as are its dependent claims 18 and 19.

It is therefore respectfully requested that the anticipation rejections of claims 13, 18 and 19 be withdrawn.

Claims 14 and 20 to 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Gruendl reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

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not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 14 has been rewritten.

Also, claims 14 and 20 to 24 depend from claim 13, and are therefore allowable for essentially the same reasons. Also, claims 20 and 21 include features in which the “energy supply field lies substantially opposite to the at least one secondary part” (or opposite to the energy transmitting interface for claim 21), claim 22 includes the feature of “an initialization of the at least one secondary part”, claim 23 includes the feature of “buffered accumulators, batteries, and solar cells” and claim 24 is an independent claim to an industrial machine system.

Accordingly, it is respectfully submitted that claims 14 and 20 to 24 are allowable.

Claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over Gruendl in view of U.S. Patent No. 5,497,038 (“Sink”).

Claim 15 depends from claim 13 and is therefore allowable for the same reasons. This is because Sink does not cure – and is not asserted to cure -- the deficiencies of Gruendl as to claim 13, as explained above. Furthermore, Gruendl does not disclose the linear motor as in claim 15 with the exception of the coil drive unit. Claim 15, for example, includes the feature of a support unit for providing rigid support of the at least one secondary part, which is not disclosed or suggested by the Gruendl reference.

Accordingly, it is respectfully submitted that claim 15 is allowable.

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As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 13 to 15 and 18 to 24 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since they have been obviated. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully submitted,

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